

### **REMARKS**

Claims 38, and 40-70 remain pending after entry of this amendment. Claim 38 was amended herein; and claims 48-70 were added herein. The amended claim set is provided herewith.

Support for the amendments to claim 38 and new claim 48 can be found throughout the Applicant's specification (2001/0025192) and at paragraph 47, lines 1-3 and paragraph 53, lines 5-11. Support for newly added claims 49 and 50 can be found throughout Applicant's specification and at paragraph 47, lines 1-3. Support for newly added claims 51-70 can be found throughout the specification.

### **Advisory Action**

The Advisory Action mailed September 18, 2007 stated that the Amendments presented in Applicants' unentered After Final Response September 14, 2007 raised new issues that would require further search and consideration. The Amendment presented herein includes the same amendments as the September 14, 2007 Response. Thus, according to MPEP706.07(b)<sup>1</sup>, an Office Action issued in reply to this Response cannot properly be made final.

### **Rejection Under 35 U.S.C. § 112**

Applicant assumes that because this rejection was not noted in the July 31, 2007 Final Office Action that it was overcome by the April 2, 2007 response.

### **Rejection Under 35 U.S.C. § 102**

Claims 22-26, 29-31, 33, 34, 36-38, 40-43, 46, and 47 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hoffman (U.S. Patent No. 5,534,022). Applicant respectfully traverses this rejection. Applicant notes that claims 22-37 have been

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<sup>1</sup> MPEP 706.07(b) states, "it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search ..."

cancelled herein, but will address this rejection as it applies to newly amended claim 38 and thereby to claims 40-43, 46, and 47.

The Office Action alleges that Hoffman shows the use of a distal electrode 38, coil electrode 20, proximal ring electrode 36, and another proximal ring electrode as element 20' (Final Office Action, page 2). Applicant respectfully asserts that element 20' of Hoffman is not a ring electrode that is made of a solid surface material as amended claim 38 recites. The element 20' of Hoffman is another defibrillation electrode (Hoffman, column 8, lines 39-41). Figure 4 and the accompanying text shows that defibrillation electrode **20** is constructed of a plurality of electrode coils **24** that are helically wound around a flexible tubular supporting core **22** (Hoffman, column 5, lines 57-60). Hoffman provides a more detailed description of the electrode coils **24** by stating that they are preferably a helically wound metal wire, which may be round or flat in cross section (Hoffman, column 6, lines 52-56). A helically wound metal wire is not analogous to a solid surface material. Because Hoffman does not teach a third ring electrode, it does not anticipate claim 38. Applicant also notes that there may be other reasons why claim 38 is not anticipated by Hoffman, and independent reasons why rejected claims 40-43, 46, and 47 are not anticipated by Hoffman; Applicant does not concede any such arguments by having not presented them herein.

**Rejection Under 35 U.S.C. §§ 102/103**

Claims 28, 32, 35, and 45 are rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over Hoffman. Applicant respectfully traverses this rejection. Applicant notes that claims 22-37 have been cancelled herein, but will address this rejection as it applies to newly amended claim 38, and thereby to claim 45.

Applicant reiterates the comments offered above with respect to Hoffman not disclosing a third ring electrode that is made of a solid surface material. According to MPEP § 2142, three basic criteria must be met in order to establish a *prima facie* case of obviousness. First, the prior art reference (or references when combined) must teach or suggest all of the elements of the rejected claims. Second, there must be some suggestion

or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Third, there must be a reasonable expectation of success.

Applicant asserts that one of skill in the art would not have been motivated to modify the lead of Hoffman to render it analogous to the lead of claim 38 by utilizing a solid surface material electrode instead of a helically wound wire electrode. The electrode 20', which the Final Office Action asserts is analogous to the recited third electrode, is utilized by Hoffman for defibrillation and sensing (Hoffman, column 5, lines 16-19). Hoffman also notes that "because the electrode coil wire is longer and thinner than the electrode elements of the prior art, the electrode of the present invention can be made with a certain amount of resistance along its entire length...This property of the electrode can be used to direct defibrillation energy to selected regions of the heart by careful choice of connection locations of electrode to conductor (Hoffman, column 7, lines 28-34). Because the wire itself as well as the length and width of the wire that makes up the electrode coil provides an advantage over the prior art, one of skill in the art would not be motivated to modify that element of Hoffman's lead, because to do so would negate that advantage.

Because a *prima facie* case of obviousness cannot be established with respect to claim 38, Applicant respectfully submits that it is not obvious in view of Hoffman. Applicant also asserts that there may be other reasons why claim 38 is not obvious over Hoffman, and independent reasons why claim 45 is not obvious in view of Hoffman; Applicant does not concede any such arguments by having not presented them herein.

**Rejection Under 35 U.S.C. § 103**

Claims 27 and 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoffman. Applicant respectfully traverses this rejection. Applicant notes that claim 27 has been deleted herein. In response to the rejection of claim 44, Applicant reiterates the comments above with respect to claim 38; and asserts that claim 44 is not obvious because it is dependent on claim 38, which is not obvious. Applicant also notes that there

may be independent reasons why claim 44 is not obvious in view of Hoffman; Applicant does not concede such arguments by having not presented them herein.

Applicant therefore respectfully requests that the rejection of claims 27 and 44 should be withdrawn.

**Conclusion**

Applicant also notes that there may be other arguments which were not presented herein, and Applicant does not concede those arguments by not having presented them herein. Applicant also does not necessarily agree with the correctness of statements made in the Office Action that were not rebutted herein.

In view of the foregoing amendments, Applicants respectfully request reconsideration and allowance of the claims as all rejections have been overcome. Early notice of allowability is kindly requested.

The Examiner is respectfully requested to contact the undersigned by telephone at 651.259.6702 or by E-mail at [anelson@cnwiplaw.com](mailto:anelson@cnwiplaw.com) with any questions or comments.

Please grant any extension of time, if necessary for entry of this paper, and charge any fee due for such extension or any other fee required in connection with this paper to Deposit Account No. 50-3964.

Respectfully Submitted,

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